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July 15, 1999

William D. Harris, Jr., Esq.  
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Re: *Printing Research, Inc., et al. v. Williamson Printing Corporation, et al.*  
Civil Action No. 3:99-CV-1154-D

Dear Bill:

Pursuant to our telephone conversation last week, I am enclosing one copy of each of the following papers:

- (1) Application for Reissue of U.S. Patent No. 5,630,363 Under U.S.C. §251 and 37 C.F.R. §1.171;
- (2) Reissue Declaration of Bill L. Davis and Jesse S. Williamson;
- (3) Submission of Cut-Up Specification and Drawings Under 37 C.F.R. §1.173;
- (4) Assignee's Offer to Surrender U.S. Patent 5,630,363;
- (5) Order for Title Report;
- (6) Declaration and Power of Attorney;
- (7) Assent of Assignee for Reissue of U.S. Patent 5,630,363;

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- (8) Information Disclosure Statement and Appendix; and,
- (9) Cover page marked Confidential Information Sought to be Expunged on the envelope containing Petition to Expunge Under 37 C.F.R. § 1.59(b) and M.P.E.P. § 724.05 and Joint Declaration of Bill Davis and Jesse S. Williamson.

As indicated in the last item above, the petition to expunge and the joint declaration of Bill Davis and Jesse S. Williamson were submitted to the Patent Office as confidential information. As of this time, these documents will not be made available to others by the Patent Office and, therefore, it is not appropriate to make them available to you. Without prejudice and without waiving any of our clients' rights, I can tell you that the joint declaration contains information relating to the inventorship issue raised by your clients. Even though this information cannot be obtained from the Patent Office, we are willing to provide it to you upon the happening of the following: first, agreement to a protective order governing the access to and use of confidential information; and second, the filing in the Patent Office of Plaintiffs' declaration setting forth in full their position on the issues of sole and joint inventorship with respect to the invention of the '363 patent.

We believe a protective order is appropriate to protect the confidential information of both parties. The joint declaration submitted with the petition to expunge contains Williamson's confidential information. In all likelihood, Plaintiffs will also be submitting documents and other materials containing confidential information to the Patent Office. Thus, it clearly is in the interest of both parties to enter into a protective order.

In regard to the form of the protective order, it can be structured as a contract or an order that would be filed with the court, if permitted by Judge Fitzwater. In any event, the protective order would be provided to the Patent Office.

As indicated in our motion to stay, we want the Patent Office to consider all known prior art, as well as any and all other material information. In that regard, we believe that several of your clients' United States and foreign patent applications, and the prosecution histories and the prior art relating to them, may contain material information and, therefore, a request that we be provided copies of them. Based on the information currently available to me, these applications include the following:

- (1) U. S. Application Serial No. 08/435,798 filed May 4, 1995, and the foreign counterparts thereof, including European Patent Application 741,025, Canadian Patent No. 2,175,731 and Japanese Application 96146371;

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- (2) Foreign counterparts of U. S. Patent No. 5,598,777, including European Patent Application 767,057 and Japanese Application 96281425;
- (3) Foreign counterparts of U. S. Patent No. 5,651,316, including European Patent Application 767,054 and Japanese Application 96281425;
- (4) U. S. Application Serial No. 08/538,422 filed October 2, 1995 and foreign counterparts thereof, including European Patent Application 767,058 and Japanese Application 96281420; and,
- (5) U. S. Patent Application Serial No. 08/538,021 filed October 2, 1995, and foreign counterparts thereof.

I would appreciate it if you would call me as soon as possible in regard to entering into a protective order.

Yours very truly,

  
John P. Pinkerton 

JPP:ksp

Enclosures

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